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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,905	02/23/2006	Colin Watts	FBR0002-100	3003
34132	7590	02/06/2008		
COZEN O'CONNOR, P.C. 1900 MARKET STREET PHILADELPHIA, PA 19103-3508			EXAMINER KAPUSHOC, STEPHEN THOMAS	
			ART UNIT 1634	PAPER NUMBER
			MAIL DATE 02/06/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/526,905

Applicant(s)

WATTS ET AL.

Examiner

Stephen Kapushoc

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 19, 26, 27, 37, 42, 43, 47-52, 55, 58, 59, 63, 69, 72 and 75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1-14, 19, 26, 27, 37, 42, 43, 47-52, 55, 58, 59, 63, 69, 72 and 75.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1, 2, 3, 12, and 19 in part as they apply to methods requiring nucleic acid analysis, and claims 4-11, 13, and 14 in full, drawn to methods for cancer cell analysis requiring nucleic acid analysis.

Group 2, claim(s) 1, 2, 3, 12 and 19 in part as they apply to methods requiring protein analysis, and claims 55 and 75 in full, drawn to methods for cancer cell analysis requiring protein analysis.

Group 3, claim(s) 26, drawn to nucleic acids for detecting cancer cells.

Group 4, claim(s) 27, 43, 47, 48, 49, and 50, drawn to proteins and kits comprising proteins.

Group 5, claim(s) 37 and 42, drawn to antibodies.

Group 6, claim(s) 51 and 52, drawn to methods of isolating a protein complex.

Group 7, claim(s) 58 and 69, drawn to methods for determining a protein complex modulator.

Group 8, claim(s) 63, drawn to methods for treatment comprising administering a compound.

Group 9, claim(s) 69 and 72, drawn to antisense nucleic acids.

### **Further Lack of Unity Restriction Requirement:**

If Applicants elect the invention of Group 1, Applicants shall further select one element from each of: (I) – a single polypeptide sequence identified by a SEQ ID NO from the groups consisting of SEQ ID NOs: 2 and 4 (relevant to claim 6); (II) a single specific nucleic acid probe or primer selected from the group consisting of: SEQ ID NO: 3, 5, 6, 7, 24 and 25, 26 and 27, 28, 29 and 30, 33 and 34, 37 and 38, 40. Claims that recite specific elements will only be examined in so far as they require the selected elements. Claims reciting only non-selected elements will be withdrawn as to a non-elected invention.

If Applicants elect the invention of Group 3, Applicants shall further select a specific sequence from the group consisting of: a sequence that encodes SEQ ID NO: 4 lacking VLLLPL, SEQ ID NO: 3, 5, 6, 7, 24 and 25, 26 and 27, 28, 29 and 30, 33 and 34, 37 and 38, 40. Claims that recite specific elements will only be examined in so far as they require the selected element. Claims reciting only non-selected elements will be withdrawn as to a non-elected invention.

**Claim Notes:**

Part (xx) of claim 13 recites 'amplification using (xvii) and (xix)', where the phrase 'amplification using (xviii) and (xix)' may be intended.

Claim 42 is placed in Group 5 as drawn to an antibody, however the claim recites 'the antibody of claim 3', where claim 3 does not recite or require any antibody.

Applicants should check claim all of the pending claims to ensure they are written as intended.

2. The inventions listed as Groups 1-9 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

3. The common technical feature among the various groups in the EDD sequence of map position 8q22.3 and the encoded EDD protein. However, such a technical feature is not a special technical feature because the EDD gene and encoded protein is taught by the prior art of Callaghan et al (1998; WO 98/48010).

4. Regarding the Further Lack of Unity Restriction Requirement, the different elements identified by different SEQ ID NOs are unique because they are composed of different nucleotide sequences that are not common to one another.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship

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must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Kapushoc whose telephone number is 571-272-3312. The examiner can normally be reached on Monday through Friday, from 8am until 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached at 571-272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days.

Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

/Stephen Kapushoc/  
Art Unit 1634

/Jehanne Sitton/  
Primary Examiner  
1/29/2008